REMARKS

Status of the Claims

The Office Action dated January 29, 2003 has been received and its contents carefully considered. Claims 1-25 are pending. Claims 1-25 have been rejected. Claims 1 and 21 have been amended.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Office Action

Claim 1 was rejected to because of an informality. Claim 1 has been amended and is believed to overcome the objection.

Claims 1-4, 10 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,884,202, Arjomand. Without conceding the propriety of the rejection independent claims 1 and 21 have been amended. It is respectfully submitted that Arjomand does not teach, *inter alia*, "a user interface having at least one <u>integrally connected communications port</u> configured for remote updating of at least one of a diagnostic application program and memory of said tool, wherein said microprocessor, non-volatile storage device, and user interface are integrally connected to said diagnostic tool" as recited in claim 1. Additionally, Arjomand does not teach, *inter alia*, a "means for interfacing with the diagnostic tool having at least one <u>integrally connected communications port</u> for remote updating at least one of a diagnostic application program and a memory of said tool, wherein said executing means, storing means and interfacing are integrally connected to said diagnostic tool" as recited in claim 21.

Arjomand on the other hand, teaches away from the present invention by disclosing a modular wireless diagnostics test and information system comprised of various independent components. For instance, in FIG. 8, a main control module 12, a digital volt-ohm meter 16, a vehicle communication interface 14, an engine analyzer 48, and an interface module 46 are separately and independently utilized to communicate, for instance, to an operator. Arjomand discloses that the DVOM firmware may be upgraded by flash reprogramming instead of a physical read-only memory (ROM) replacement. Thus, Arjomand teaches away from the present invention because the DVOM is not integrally connected to the diagnostic tool as claimed in claims 1 and 21.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Arjomand cannot be said to anticipate the present invention as claimed.

Claims 2-4 and 10 dependent ultimately from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 4-9, 11-20 and 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arjomand. Arjomand fails to disclose or fairly suggest all the specific method steps, such as, for example, displaying the upgrading procedure, and other details recited, such as, for example, having the remote terminal connected to the internet as conceded in the Office Action. The Examiner contends that the aforementioned details "fall within the realm of engineering design choice" and furthermore "the steps and details are well known in the art." Nevertheless, Arjomand fails to teach the claimed invention including, for instance, "displaying

upgrade procedures", "determining whether said diagnostic tool is valid for an update", "determining whether a valid smart card is present", and "providing user notification of the requested upgrade" as required by the method of claim 21 of the present invention. The Examiner has failed to rely on an additional reference to cure the deficiencies of Arjomand, and thus if a rejection on this basis is maintained, it is respectfully requested that the Examiner provide a reference or elaboration in support of the rejection.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re: Wilson, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970).* Since the prior art does not teach or suggest all the claimed features, withdrawal of the rejection is respectfully requested.

Claims 4-9 and 11-19 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 22-25 ultimately depend from independent claim 21 and are patentable over the cited prior art for at least the same reasons as is claim 21.

In view of the foregoing, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the

application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at

202-861-1538.

Respectfully submitted,

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Attachment:
    Appendix

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APPENDIX

VERSION WITH MARKINGS SHOWING CHANGES MADE

IN THE CLAIMS

1.   (Twice Amended) A diagnostic tool for communicating with a vehicular

electronic control unit, said diagnostic comprising:

a microprocessor for executing an operating system and one <u>or</u> more diagnostic

application programs;

a non-volatile storage device , in [the] <u>a</u> form of at least one internal and external

memory, coupled to said microprocessor; and

a user interface <u>having at least one integrally connected communications port</u>

configured for remote updating of at least one of a diagnostic application program and memory

of said tool, wherein said microprocessor, non-volatile storage device, and user interface are

integrally connected to said diagnostic tool.

21.   (Twice Amended) A diagnostic tool for communicating with a vehicular

electronic control unit, said diagnostic tool comprising:

means for executing an operating system and one or more diagnostic application

programs;

means for storing diagnostic application programs, said storing means comprising

at least one internal and external memory coupled to said means for executing; and

means <u>for interfacing with the diagnostic tool having at least one integrally</u>

<u>connected communications port</u> for [remotely] <u>remote</u> updating at least one of a diagnostic

application program and a memory of said tool, wherein said executing means, storing means,

and [updating] <u>interfacing</u> means are integrally connected to said diagnostic tool.